

**REMARKS**

I. Status of the Claims

Claims 1-9, 11-23, and 25-34 are pending in this application, and have been rejected.

II. Abstract

Applicants have amended the abstract. No new matter has been added.

III. Rejections Under 35 U.S.C. § 112, ¶ 1

The Examiner has rejected claim 8 under 35 U.S.C. § 112, first paragraph, “as failing to comply with the enablement requirement.” Applicants respectfully traverse this rejection.

Claim 8 recites “[t]he system of claim 1 wherein said gaming server further comprises a file compression codec filter.” This claim was part of the application filed on April 12, 2001, and thus is part of the application’s original disclosure. *See Northern Telecom, Inc. v. Datapoint Corp.*, 908 F.2d 931, 938, 15 USPQ2d 1321, 1326 (Fed. Cir. 1990); *In re Koller*, 613 F.2d 819, 823-24, 204 USPQ 702, 706 (CCPA 1980) (“original claims constitute their own description.”); MPEP § 608.01(I). The disclosure in an originally filed claim satisfies the requirements for § 112. *See Union Oil of Cal. v. Atlantic Richfield Co.*, 208 F.3d 989, 998 n.4, 54 USPQ2d 1227, 1233 n.4 (Fed. Cir. 2000); *see also Hyatt v. Boone*, 146 F.3d 1348, 1352, 47 USPQ2d 1128, 1130 (Fed. Cir. 1998) (“The claims as filed are part of the specification, and may provide or contribute to compliance with Section 112.”).

In addition, Applicants respectfully submit that the specification of the application enables a person of ordinary skill to make and use the invention of claim 8 without undue experimentation. For example, compression codecs are discussed on page 3, line 25 through page 4, line 1.

Accordingly, Applicants request that the rejection of claim 8 under § 112, first paragraph, be withdrawn and that the pending claim be allowed.

IV. Rejections Under 35 U.S.C. § 103(a)

A. Claims 1-2, 4-6, 9, 11-15, 25-27, and 34

The Examiner has rejected claims 1-2, 4-6, 9, 11-15, 25-27, and 34 under 35 U.S.C. § 103(a) “as being unpatentable over Karmarkar (US Patent No. 6,508,709) in view of Patel et al. (US Patent No. 6,731,600).” Applicants respectfully traverse these rejections.

*Claim 1* is directed to an interactive gaming system that includes a data network in communication with a user computer, a gaming server in communication with the data network, and a wagering device in communication with the gaming server. The wagering device is located remotely from the user computer, and the user computer remotely controls the wagering device. The system further includes a bandwidth and transmission detection device, wherein transmissions between the user computer and the wagering device are optimized using encryption and compression techniques.

Applicants respectfully submit that the Patent Office has not established a *prima facie* case of obviousness of the pending claims. With regard to claim 1, the Office action states that “[a]lthough Karmarkar uses encryption and compression techniques to transfer data, he fails

to disclose providing a bandwidth and transmission detection device to his system.” Office action at page 3. Faced with this deficiency in the Karmarkar reference, the Examiner argues that “Patel teaches a system and method for determining network conditions in which he includes [a] bandwidth and transmission detection device, see abstract, 6:4-15.” *Id.* at pages 3-4. The Examiner then concludes that “[i]t would have been obvious to one of ordinary skill in the art at the time the invention was made to provide the detection device as taught by Patel in the Karmarkar type system in order to estimate the amount of available transmission bandwidth between the server computer and the client computer.” *Id.* at page 4. But the Office action provides no explanation, citation to the references, or other evidence to support this conclusory statement.

Under § 103, the Patent Offices bears the burden of establishing a *prima facie* case of obviousness. *In re Fine*, 837 F.2d 1071, 1074, 5 USPQ2d 1596, 1598-99 (Fed. Cir. 1988). To establish a *prima facie* case of obviousness, the Examiner must identify “some objective teaching in the prior art or ... knowledge generally available to one of ordinary skill in the art [that] would lead that individual to combine the relevant teachings of the references.” *Id.* “The motivation, suggestion or teaching may come explicitly from statement in the prior art, the knowledge of one of ordinary skill in the art, or, in some cases the nature of the problem to be solved.” *In re Kotzab*, 217 F.3d 1365, 1370, 55 USPQ2d 1313, 1316-17 (Fed. Cir. 2000). But the Court of Appeals for the Federal Circuit has made it clear that broad conclusory statements standing alone are not sufficient. *Id.*

The Office action does not identify any objective teaching in the prior art or knowledge generally available to one of ordinary skill that would lead that individual to combine features of the Patel *et al.* reference with those of Karmarkar. Thus, Applicants respectfully submit that the Examiner's combination of individual features from Karmarkar with those of Patel *et al.* constitutes improper hindsight reconstruction, which does not meet the *prima facie* requirements of § 103.

**Claims 2, 4-6, and 9** depend directly from claim 1, and thus contain all of the features recited in claim 1. Because the Office action does not state a *prima facie* case of obviousness with respect to claim 1, it also fails with respect to claims 2, 4-6, and 9.

Accordingly, Applicants respectfully submit that claims 1-2, 4-6, 9, 11-15, 25-27, and 34 are not obvious in view of the Examiner's combination of Karmarkar and Patel *et al.* Applicants thus respectfully request withdrawal of the rejections under 103(a) and allowance of the pending claims.

**B     Claim 7**

The Examiner has rejected claim 7 under 35 U.S.C. § 103(a) "as being unpatentable over Karmarkar (US Patent No. 6,508,709) in view of Patel et al. (US Patent No. 6,731,600) and further in view of Watt (US Patent No. 5,781,532)." Applicants respectfully traverse this rejection.

**Claim 7** depends directly from claim 1, and thus contains all of the features recited in claim 1. As stated above in connection with claim 1, Applicants respectfully submit that the Office action fails to state a *prima facie* case for combination of the Karmarkar and Patel

*et al.* references. The Examiner relies on the improper combination in connection with claim 7 as well. Thus, the Office action fails to state a *prima facie* case of obviousness as to claim 7.

Accordingly, Applicants respectfully request withdrawal of the rejection of claim 7 under § 103 and allowance of the pending claims.

C. Claim 8

The Examiner has rejected claim 8 under 35 U.S.C. § 103(a) “as being unpatentable over Karmarkar (US Patent No. 6,508,709) in view of Patel et al. (US Patent No. 6,731,600) and further in view of Khosla (of record).” Applicants respectfully traverse this rejection.

**Claim 8** depends directly from claim 1, and thus contains all of the features recited in claim 1. As stated above in connection with claim 1, Applicants respectfully submit that the Office action fails to state a *prima facie* case for combination of the Karmarkar and Patel *et al.* references. The Examiner relies on the improper combination in connection with claim 8 as well. Thus, the Office action fails to state a *prima facie* case of obviousness as to claim 8.

Accordingly, Applicants respectfully request withdrawal of the rejection of claim 8 under § 103 and allowance of the pending claims.

D. Claims 3 and 16-20

The Examiner has rejected claims 3 and 16-20 under 35 U.S.C. § 103(a) “as being unpatentable over Karmarkar (US Patent No. 6,508,709) in view of Patel et al. (US Patent No. 6,731,600) and further in view of Lvov.” Applicants respectfully traverse these rejections.

**Claim 3** depends directly from claim 1, and thus contains all of the features recited in claim 1. As stated above in connection with claim 1, Applicants respectfully submit that the Office action fails to state a *prima facie* case for combination of the Karmarkar and Patel *et al.* references. The Examiner relies on the improper combination in connection with claim 3 as well. Thus, the Office action fails to state a *prima facie* case of obviousness as to claim 3.

**Claims 16-20** depend directly from claim 12, and thus contain all the features recited in claim 12. As stated above in connection with claim 1, Applicants respectfully submit that the Office action fails to state a *prima facie* case for combination of the Karmarkar and Patel *et al.* references. The Examiner relies on the improper combination in connection with claims 12 and 16-20 as well. Thus, the Office action fails to state a *prima facie* case of obviousness as to claims 12 and 16-20.

Accordingly, Applicants respectfully request withdrawal of the rejection of claims 3 and 16-20 under §103 and allowance of the pending claims.

E. Claims 21-23

The Examiner has rejected claims 21-23 under 35 U.S.C. § 103(a) “as being unpatentable over Karmarkar in view of Patel and further in view of Graves (of record).” Applicants respectfully traverse these rejections.

**Claims 21-23** depend directly or indirectly from claim 12, and thus include all of the features recited in claim 12. As stated above, Applicants respectfully submit that the Office action fails to state a *prima facie* case for combination of the Karmarkar and Patel *et al.* references. The Examiner relies on the improper combination in connection with claims 21-23

as well. Thus, the Office action fails to state a *prima facie* case of obviousness as to claims 21-23.

Accordingly, Applicants respectfully request withdrawal of the rejection of claims 21-23 under §103 and allowance of the pending claims.

F. Claims 28-31

The Examiner has rejected claims 28-31 under 35 U.S.C. § 103(a) “as being unpatentable over Karmarkar in view of Patel and further in view of Vuong (US Patent No. 5,762,552).” Applicants respectfully traverse these rejections.

*Claims 28-31* depend directly or indirectly from claim 12, and thus include all of the features recited in claim 12. As stated above, Applicants respectfully submit that the Office action fails to state a *prima facie* case for combination of the Karmarkar and Patel *et al.* references. The Examiner relies on the improper combination in connection with claims 28-31 as well. Thus, the Office action fails to state a *prima facie* case of obviousness as to claims 28-31.

Accordingly, Applicants respectfully request withdrawal of the rejection of claims 28-31 under § 103, and allowance of the pending claims.

V. Conclusion and Request for Reconsideration

Applicants request reconsideration of the present application in view of the aforementioned amendments and remarks. Although other features of the claims in the present application are also significant, Applicants respectfully submit that the claims are allowable for

at least the aforementioned reasons. Accordingly, Applicants respectfully request that the rejections under §§ 103 and 112 be withdrawn, and that the pending claims be allowed.

In the event that a telephone conference would advance examination of this application, the Examiner is invited to contact the undersigned at the number provided.

VI. Authorization

Applicants submit herewith a check in the amount of \$1,020.00 and Petition for Extension of Time requesting a three-month extension of time. Applicants respectfully submit that no further extension of time or additional fee is due. In the event that the Commissioner determines that an additional fee is due for this paper, or that a petition for an extension of time is required, the undersigned hereby so petitions and authorizes the Commissioner to charge any fees required therefor to Milbank's deposit account no. 13-3250, order no. 30554-05700. A DUPLICATE COPY OF THIS PAGE IS ENCLOSED HEREWITH.

Respectfully submitted,  
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